

REMARKS

In the Office Action mailed March 12, 2002, the preliminary amendments to the specification dated 8-7-01 had not been entered. The drawings were objected to under 37 CFR 1.83(a). Next, claims 20 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spei et al. in view of Moller. Finally, claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Spei et al. in view of Moller as above, and further in view of Brown. Claims 1-19 have been cancelled and claims 20-22 remain active in the application. No new matter has been added.

The Examiner states that the preliminary amendments to the specification dated 8-7-01 do not comply with the revised procedures in 37 CFR 1.121. The preliminary amendments are being re-presented in proper form. The amendment set forth hereinabove claims benefit of an earlier filing date in compliance with 37 CFR 1.78. The insertion in the specification at page 4 for the concentration ranges provides correspondence between the claims and specification. Said ranges are supported by the original claims 3, 5, and 10. Accordingly, the amendments to the specification should now be entered.

Next, the drawings were objected to under 37 CFR 1.83(a). This rejection is respectfully traversed. Enclosed please find 1 sheet of an informal drawing for the above-identified patent application wherein wastewater treatment plant 28 and incinerator 30 have been are now shown. The specification has been amended to recite the features 28 and 30 shown in the Figure 2. Support for the amendment to the drawings can be found, for example, in claims 21 and 22. No new matter has been added. Accordingly, it is respectfully requested that the objection to the drawings under 37 CFR 1.83(a) should now be withdrawn.

Next, claims 20 and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spei et al. in view of Moller. This rejection is respectfully traversed.

Spei et al, U.S. Patent No. 4,961,858, generally discuss a process for demulsifying an oil-in-water emulsion comprising adding an organic polyamine emulsifier to said

emulsion in a separation vessel by means of a metering device for the controlled addition of said demulsifier, and conducting the demulsifying process at a temperature of from about 60°C to about 90°C, while mixing the emulsion and demulsifier to provide a demulsified product having a water content of less than about 10% by weight based on the weight of said emulsion. See Claim 1.

Moller, U.S. Patent No. 5,149,440, generally discusses an apparatus and method for resolving an emulsion that has an aqueous phase and an organic phase that includes components capable of polymerizing or coagulating. The emulsion is added to a tank and heated. A non-corrosive inorganic separation aid incapable of initiating polymerization of the emulsion or its constituents is added to the tank with mixing to cause the emulsion to separate into its constituent aqueous and organic phases. The contents of the tank are then allowed to settle and the separated aqueous and organic phases are removed from the tank. See Abstract.

Spei et al. in view of Moller do not singly or in any reasonable combination disclose, teach, or suggest the recited invention as claimed in independent claim 20. Specifically, there is no teaching, suggestion, or disclosure of a system for the treatment of silicone emulsion waste comprising a silicone emulsion waste reservoir; at least one chemical tank containing chemicals for separating the silicone emulsion waste; at least one mixing tank in communication with the silicone emulsion waste reservoir and the at least one chemical tank, wherein the silicone emulsion waste and chemicals are mixed in the mixing tank and the silicone emulsion waste is separated into a silicone oil laden liquid and an emulsion-free water; a water tank that receives the emulsion-free water from the mixing tank; and an oil tank which receives silicone oil liquid from the mixing tank. Section 2141.01 of the MPEP states that, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious Distilling an invention down to the gist or thrust of an invention disregards the requirement of analyzing the subject matter as a whole”. Spei et al., although concerned with demulsifying oil/water emulsions, use a metering device, which is an integral part to the Spei invention. (See Figure 2.) Spei et al. use a metering

device in order to control the addition of said demulsifier. There is no suggestion or disclosure in Spei et al. to not use a metering device. The Examiner has not given any support that Spei et al. can be practiced without a metering device. Additionally, Spei et al. use one set of tanks to mix the oil and water emulsion and another tank to separate the oil and water. Spei et al. make no mention of a mixing tank as recited in the present invention wherein both mixture and separation of the silicone emulsion waste occurs. Moller discusses a specific apparatus adapted to mix the oil and water emulsion and another tank to separate the oil and water and is not concerned with a mixing tank as recited in the present invention wherein both mixture and separation of the silicone emulsion waste occurs. Additionally, Moller uses a separate mix pump to recirculate the tank contents, which is a necessary part of his invention. (See Col. 3, lines 48-50.) The Examiner has not given any support that Moller can be practiced without a separate mix pump. Accordingly, it is respectfully requested that the rejection of claim 20 and 22 under 35 U.S.C. 103(a) should now be withdrawn.

Furthermore, neither the Spei reference nor the Moller reference provides a teaching or suggestion to make the combination suggested in the Office Action. “Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 932, 933 (Fed. Cir. 1984). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (rev. Feb. 2000) citing In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original). Therefore, since no suggestion can be found in the Spei reference or the Moller reference, the rejection of claims 20 and 22 under 35 USC 103(a) is improper and should now be withdrawn.

As discussed above, the Spei et al. and Moller references either singly or in combination would not meet all the limitations of the present invention. As such, it can only be concluded that the Spei et al. and Moller references were combined by hindsight reconstruction. “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blue print for piecing

together the prior art to defeat patentability - the essence of hindsight." In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As such, since the combination of the Spei et al. and Moller references was made by hindsight reconstruction, the rejection under 35 USC 103(a) is improper and should now be withdrawn.

Finally, claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over Spei et al. in view of Moller as above, and further in view of Brown.

Brown generally discusses the separation of liquid waste generated aboard a maritime vessel. The liquid waste is separated into oily and non-oily components for separate treatment to obtain flow streams having different waste contents. Those of the flow streams having waste content reduced by the treatment are discharged while the other flow streams having concentrated waste content are subject to incineration. See Abstract.

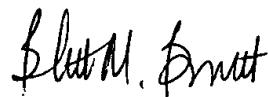
Brown either singly or in any reasonable combination with the applied art, does not teach, suggest, or disclose the recited invention as claimed in dependent claim 21. Brown focuses on liquid waste generated aboard a maritime vessel with a treatment system that includes separate non-oily waste treatment and oily waste treatment as well as sewage vacuum collection, waste oil collection, an incinerator feed tank, a liquid waste incinerator, and overboard discharge. Specifically, there is no teaching, suggestion, or disclosure of a system for the treatment of silicone emulsion waste comprising a silicone emulsion waste reservoir; at least one chemical tank containing chemicals for separating the silicone emulsion waste; at least one mixing tank in communication with the silicone emulsion waste reservoir and the at least one chemical tank, wherein the silicone emulsion waste and chemicals are mixed in the mixing tank and the silicone emulsion waste is separated into a silicone oil laden liquid and an emulsion-free water; a water tank that receives the emulsion-free water from the mixing tank; and an oil tank which receives silicone oil liquid from the mixing tank. In addition, there is no evidence in the prior art to suggest the combination of these particular prior art devices. Accordingly, it

is respectfully requested that the rejection of claims 21 under 35 U.S.C. 103(a) should be withdrawn.

As discussed above, the Spei et al., Moller, and Brown references either singly or in combination would not meet all the limitations of the present invention. As such, it can only be concluded that the references were combined by hindsight reconstruction. Thus, since the combination of the Spei et al., Moller, and Brown references was made by hindsight reconstruction, the rejection of claim 21 under 35 USC 103(a) is improper and should now be withdrawn.

In view of the reasons set out above, it is respectfully submitted that claims 20-22 which stand rejected in this application, are patentably distinct from the art cited in the Office Action received March 20, 2002 and are in condition for allowance. Favorable action on these claims is requested.

Respectfully submitted,



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Attachments: 1 Page



Marked Up Copies to All Amendment From Amendment and Response to Office Action dated March 12, 2002.

IN THE SPECIFICATION:

Page 3, line 12-19, please replace the following paragraph:

A silicone emulsion typically comprises a mixture of silicone oil and water, which can be stabilized by a surfactant blend. The surfactant blend comprises a combination of at least one of nonionic, anionic, and cationic surfactants. Waste from the production of silicone emulsions can comprise approximately 50% of waste from the method that is sent to an incinerator 30. This stream can be intercepted before mixing and combined with other materials, so that water can be removed. Thereby, the wastewater load that is sent to the incinerator 30 can be reduced.

Page 3, line 24 – page 4, line 6, please replace the following paragraph:

Chemical materials for separating the silicone emulsion waste are contained in a separate tank 16. These chemicals can be pumped from the tank 16 to a mixing tank 14 via a conduit 18. In mixing tank 14, when separated, the remaining emulsion or silicone oil 20 will float on top of the emulsion-free water 22, which can be easily separated. The emulsion-free water 22 can be drained to a water tank 24. The silicone oil 20 can be transferred to an oil tank 26. The silicone oil 20 [22] can be recycled or incinerated. The emulsion-free water 22 can be recovered from the emulsion by separating, and can be discharged to a wastewater treatment plant 28.

FIG. 2

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